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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,188	03/11/2004	Christopher Prevost	00770.P1	8624
7590	12/15/2004			
JOHNSON & STAINBROOK, LLP Suite 203 3558 Round Barn Blvd. Santa Rosa, CA 95403			EXAMINER GONZALEZ, MADELINE	
			ART UNIT 2859	PAPER NUMBER

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,188

Applicant(s)

PREVOST, CHRISTOPHER

Examiner

Madeline Gonzalez

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2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 9, 11 and 13 are objected to because of the following informalities:
 - a) Claim 9: The claim recites the limitation "said back side" in line 1. There is insufficient antecedent basis for this limitation in the claim.
 - b) Claim 11: --said-- should be added after "wherein" in line 1.
 - c) Claim 13: --said-- should be added after "around" in line 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 10-12, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofmeister et al. (U.S. 6,739,065) [hereinafter Hofmeister] in view of Wegman (U.S. 6,026,584).

Hofmeister discloses a hanging device, as shown in Fig. 1, having:

- a vertical member 20 having an upper end, a lower end, and a longitudinal axis;
- a horizontal bar 30 attached to said vertical member with connection means proximate said upper end and having a longitudinal axis substantially perpendicular to said longitudinal axis of said vertical member, and further including leveling means 180;
- a marking tool assembly releasably connected to said vertical member 20 and slidable along said longitudinal axis of said vertical member 20, said marking tool assembly including a marking tool 110 having a tip 115, and retention means 260 for bearing an object by its wall fastener hardware during use;
- wherein said vertical member 20 includes at least a front side and a back side;
- wherein said vertical member 20 further includes a slot 50 running proximate said lower end to proximate said upper end;
- wherein said leveling means 180 is a level bubble disposed in a substantially parallel orientation to said longitudinal axis of said horizontal bar 30;
- wherein said horizontal bar 30 is generally elongate and includes at least a bottom side and a back side;
- wherein said bottom side of said horizontal bar 30 is substantially planar and is parallel to said longitudinal axis of said horizontal bar 30;
- wherein said horizontal bar 30 has a mid-portion and further includes a recess at said mid-portion which mates with said vertical member 20, as shown in Fig. 2;

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- wherein said marking tool assembly includes a marking punch having a pointed tip comprising said marking tool tip 115;
- a clip 120 for releasably capturing an object between said clip 120 and said vertical member 20; and
- wherein said clip 120 includes a base.

Hofmeister lacks the specific connections means of the horizontal bar, a handle portion, the handle portion being integral with the vertical member, the vertical member having a bend to form the handle portion, a grip portion having a molded grip, the specific material of the clip and the specific material of the base.

With respect to the specific connections means of the horizontal bar: Hofmeister discloses a device having a horizontal bar 30 preferably integrally attached to a vertical member 20. The use of the particular type of connection means claimed by applicant, i.e., a screw, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the horizontal bar is connected to the vertical member, as already suggested by Hofmeister, and 2) the use of the particular type of connection means by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of connection means that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to connect the horizontal bar with the vertical member as already suggested by Hofmeister. Therefore, it

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would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a screw to connect the horizontal bar with the vertical member disclosed by Hofmeister in order to be able to replace one of the parts in case of damage.

With respect to the handle portion, the handle portion being integral with the vertical member, the vertical member having a bend to form the handle portion, and the grip portion having a molded grip: Wegman discloses an apparatus, as shown in Fig. 1, having a handle portion 42 connected to an disposed from said upper end of a vertical member 12, said handle portion being integral with said vertical member 12, said vertical member 12 including a bend at an upper end which directs an extension of said vertical member 12 forwardly and downwardly to form said handle portion 42, and said handle portion including a grip portion having a molded grip. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add a handle portion as taught by Wegman to the device disclosed by Hofmeister in order to facilitate gripping the device.

With respect to the specific material of the clip and the specific material of the base: Hofmeister as modified by Wegman disclose a device having a clip 120 made of some material, said clip having a base. The particular type of material used to make the clip and the base claimed by applicant, i.e., a resilient clip and a non-slip resilient clip, is only considered to be the use of a " preferred " or " optimum " material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use

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of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the clip and the base disclosed by Hofmeister as modified by Wegman of a resilient material in order to allow some flexibility and avoid damage due to the weight of the object hanged on the clip.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hofmeister (U.S. 6,739,065) in view of Wegman (U.S. 6,026,584) as applied to claims 1-8, 10-12, 19 and 20 above, and further in view of Krake et al. (U.S. 2002/0078582) [hereinafter Krake].

Hofmeister as modified by Wegman disclosed all the subject matter claimed above in paragraph 3 with the exception of padding material attached to a back side of the horizontal bar.

With respect to the padding material attached to a back side of the horizontal bar: Krake discloses a picture hanging device, as shown in Fig. 1, having padding material 9 attached to a back side of a horizontal bar in order to prevent scratching of a contacting surface and to prevent inadvertent movement of the device. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add a padding material as taught by Krake to the backside the horizontal bar disclosed by Hofmeister as modified by

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Wegman in order to prevent scratching of a contacting surface and to prevent inadvertent movement of the device.

5. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofmeister (U.S. 6,739,065) in view of Wegman (U.S. 6,026,584) as applied to claims 1-8, 10-12, 19 and 20 above, and further in view of Bogart (U.S. 610,021).

Hofmeister as modified by Wegman disclosed all the subject matter claimed above in paragraph 3 with the exception of a protective collar, the marking punch including a threaded middle portion, a cap, the specific shape of the cap, a channel, a nut, and a threaded hole.

With respect to the protective collar, the marking punch including a threaded middle portion, the cap, the nut, the threaded hole, the annular gripping structure and the retention plate: Bogart discloses a gage, as shown in Fig. 1, having a protective collar *a* disposed around a tool tip *c'*, a spindle *c* having a threaded middle portion and a cap, a nut *e* having a front side for surface-to-surface contact with a vertical member *b*, a rear side and a threaded hole extending from the front adapted to releasably capture said threaded middle portion of said spindle *c*. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the marking assembly disclosed by Hofmeister as modified by Wegman by providing the marking punch with a protective collar, a threaded middle portion and a nut in order to securely connect the marking punch to the carriage 90.

With respect to the specific shape of the cap and the channel: Hofmeister as modified by Wegman and Bogart disclosed a device having a marking punch including a cap. The specific shape claimed by applicant, i.e., a conical cap, is only considered to be an obvious modification of the shape of cap disclosed by Hofmeister as modified by Wegman and Bogart as the courts have held that a change in shape or configuration, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). With this modification a channel will be formed on the cap 260 and fastener hardware may be disposed in said channel when in use.

Allowable Subject Matter

6. Claims 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pfeffer discloses a hanging device having a vertical member, a horizontal bar, and a marking assembly having a removable rubber cap. Floyd discloses an apparatus having a

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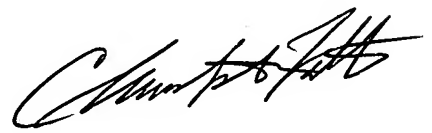
marking assembly. Gruenberg et al. ('991), Ramsey and Greene disclose devices having a handle. Lieberman, Stewart and Muchnik disclose devices having a marking tool and a protective collar around said tool. Sollars et al. ('669) discloses a device having padding material 9.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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